

Practitioner's Docket No. 1142-001**PATENT****IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of: James F. Scelis

Application No.: 10/631,204

Group No.: 3773

Filed: 07/31/2003

Examiner: M. R. Tyson

For: BIOPSY DEVICES AND METHODS

**Mail Stop Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

**PETITION UNDER (37 C.F.R. §1.183) QUESTION NOT SPECIFICALLY PROVIDED FOR OR,
IN THE ALTERNATIVE, PETITION UNDER (37 C.F.R. § 1.313(c)) WITHDRAWAL FROM
ISSUE—ISSUE FEE PAID**

1. Applicant petitions that the Examiner is compelled to consider the information disclosure statement filed on November 6, 2009 be considered, as timely filed, without the application being withdrawn from issue.
2. Alternatively, Applicant petitions that the above identified application be withdrawn from issue. The issue fee was paid on November 6, 2009.
3. Reason for withdrawal from issue:

The reason applicant seeks withdrawal from issue of this application is:

For consideration of an Information Disclosure Statement that has not been considered prior to the filing of a Request for Continued Examination.

4. Petition fee (37 CFR § 1.17(i)):

Charge Account 50-1097, \$130.00.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. section 1.8(a))

I hereby certify that, on the date shown below, this correspondence is being sent via facsimile to Karen Creesy at (571)
273-0025:

11/30/2009 LDIEP1 00000001 501097 10631204

Date:

11-25-0901 FC:1464
02 FC:2801130.00 DA
405.00 DA
SignatureWendy Morgan

(type or print name of person certifying)

Date: Nov. 25, 2009

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Practitioner's Docket No. 1142-001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: James E. Selis

Application No.: 10/631,204

Group No.: 3773

Filed: July 31, 2003

Examiner: M.R. Tyson

For: BIOPSY DEVICES AND METHODS

**Mail Stop Office of Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**

**Petition Under Rule 1.183 or, In the Alternative, Petition to Withdraw the Application
from Issue Under Rule 1.313(c)(2)**

Applicant submits this petition in the alternative to:

- (1) Compel the Examiner to consider the information disclosure statement filed on November 6, 2009, the date when Applicant paid the issue fee; or
- (2) If the above relief is denied, to withdraw the application from issue under 37 C.F.R. 1.313(c)(2) in favor of a request for continued examination.¹

Basis for Relief

The issue fee was paid on November 6, 2009. An Information Disclosure Statement (IDS) following 37 C.F.R. §§ 1.97 and 1.98 (with appropriate certification) was filed by electronic filing system (EFS) on November 6, 2009, the same day the issue fee was paid. The Examiner has refused to consider the IDS, and contends she has no duty to consider the IDS of November 6, 2009 because, though it was filed the same date, it was a separate EFS filing that was accorded a date stamp 53 minutes following the issue fee date stamp. Applicant believes there is no legal authority for the Examiner to refuse consideration of the IDS, and under 37 C.F.R. § 1.182 requests the Commissioner to compel consideration of the IDS.

¹ Applicant submits herewith a contingent request for continued examination. This request should be effective if and only if relief is not granted compelling the Examiner to consider the IDS.

There is no rule, statute, or other legal authority to support the arbitrary action taken by the Examiner. The only guidance Applicant has found so far that is analogous is the following statement from Federal Register: (October 27, 1009 (Volume 74, Number 206)).

What if the applicant electronically files an application via EFS-Web, and on that same day, realizes that the applicant has inadvertently omitted a document from the application? One advantage of filing a patent application via EFS-Web is that applicant (who is a registered user) may view the submission in PAIR and file a document directly into the application on the same day as the filing date of the application. In certain situations, applicant may correct an error by filing a missing item(s) on the same day as the filing date of the application. Applicant, however, may wish to file another new application in other certain situations. The following examples describe implications raised when applicant inadvertently omits an item when filing an application electronically via EFS-Web:

1. Oath or Declaration--Applicant may file an executed oath or declaration on the same day as the filing date as the application via EFS-Web. The oath or declaration **will not be considered late** and thus a surcharge for filing a late oath or declaration will not be required.
2. Filing Fees--Applicant may file the filing fees (e.g., the basic filing fee, search and examination fees, application size fee, or excess claims fee) on the same day as the filing date of the application via EFS-Web. The fees **will not be considered late** and thus a surcharge for filing the filing fees will not be required. (emphasis added)

Furthermore, Rule 1.97(d) says:

An information disclosure statement shall be considered by the Office if filed by the application after the period specified in paragraph (c) of this section, provided that the information disclosure statement is filed **on or before** payment of the issue fee and is accompanied by:

- (1) The statement specified in paragraph (e) of this section; and
- (2) The fee set forth in § 1.17(P).

For this to make any sense it must be construed as intended to refer to the date of the issue fee payment. The MPEP supports Applicant's position in 609.04(b)(3) it addresses the period in question and imposes "the date" interpretation: "(3) after the period in (2) but **on or before the date** the issue fee is paid."

In the alternative, if the above relief is denied, in an excess of caution, Applicant respectfully request withdrawal of this application from issue, so that the IDS can be considered in the accompanying contingent request for continued examination.² Applicants request that the application be withdrawn from issue under rule 1.313(c)(2) which lists, "consideration of a Request for Continued Examination in compliance with §1.114" as the reason for granting the petition.

²Applicant believes that the underlying cited reference is cumulative to the art of record. However, in the interest of having a complete record Applicant filed the present IDS. The cited art was actually known already to the present Examiner having been cited by her on September 21, 2009 during prosecution of a commonly owned application, but not expressly cited or applied by the Examiner in this case.

A fee of \$130.00 is believed due at this time, and if any other fee is due at this time please charge the deficiency to deposit account 50-1097.

Date: Nov. 25, 2009

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